

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

Applicant : Siamak Doroodian-Shoja
Serial No. : 09/024,371
Filed : Unknown
For : DISPOSABLE RAZOR WEAR INDICATOR
Group Art Unit : 3724
Examiner : Clark F. Dexter

New York, New York 10020
November 14, 2000

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

REQUEST FOR SUSPENSION OF PROSECUTION

OR, IN THE ALTERNATIVE,

REQUEST FOR DECLARATION OF AN
INTERFERENCE PURSUANT TO 37 C.F.R. § 1.604

Sir:

- This paper is being filed on behalf of Mingchih M. Tseng, whose Application No. 08/461,318 ("Tseng '318") is currently involved in Interference No. 104,482 (the

"Interference") with Doroodian-Shoja ("Doroodian") U.S. Patent 5,388,331 (the "Doroodian '331 Patent").

This is a request for a suspension of prosecution or, in the alternative, a request for declaration of an interference, submitted for the above-identified Doroodian U.S. Application No. 09/024,371 ("Doroodian '371").

Tseng understands that Doroodian '371 is again being prosecuted, after having apparently been inadvertently deemed abandoned by the Patent and Trademark Office.

Early on in the Interference, Tseng requested that, if Doroodian '371 were revived, it should be added to the Interference. At that time, the Administrative Patent Judge ("APJ") indicated his reluctance to add another application because he did not want to delay proceedings in the Interference.

On March 8, 2000, at the APJ's request, Doroodian "agreed to review its other pending applications to see if any contained a broader claim directed to the same patentable subject matter as that of the existing count" (Interference Paper No. 22, p. 2). Doroodian never informed the APJ or Tseng of the existence of such an application.*

* Tseng does not know whether or not Doroodian included Doroodian '371 in that review, because it was at that time deemed abandoned by the PTO.

On May 18, 2000, the APJ ordered Doroodian to give Tseng notice within ten days should Doroodian '371 be revived (Interference Paper No. 27). Doroodian gave Tseng that notice on September 15, 2000.

Tseng submits that, depending on the relationship between the claims in Doroodian '371 and the subject matter involved in the Interference, one of two events should occur regarding Doroodian '371.

REQUEST FOR SUSPENSION OF PROSECUTION

If the claims in Doroodian '371 are directed to the same patentable invention as the subject matter involved in the Interference, then, if Doroodian '371 is, or becomes, in condition for allowance, further prosecution should be suspended pending resolution of the Interference. This will avoid the undesirable result of two patents issuing for the same invention (from Doroodian '371 and Tseng '318), should Tseng later prevail in the Interference.

For the Examiner's convenience, the count (Count 1) of the Interference is set out here:

(Claim 1 of Doroodian '331)

In a disposable razor or razor cartridge comprising at least one blade mounted in a head or frame, said blade having a shaving edge, the improvement comprising wear indicator means for indicating the amount of wear on the shaving edge, said wear indicating means being located on the head or frame in close proximity to the shaving edge of said blade, and said wear indicating means

comprising a strip of material extending generally parallel to the shaving edge, said strip of material gradually wearing away as the disposable razor or razor cartridge is used in shaving, the amount of material wearing away being correlated with the amount of wear on the shaving edge to provide a visual indication of the relative wear on the blade.

OR

(Claim 135 of Tseng '318)

A razor cartridge comprising a blade and an immovable skin engaging member affixed adjacent said blade, said skin engaging member located such that it contacts the skin of a user during shaving, said skin engaging member comprising two adjoining disparately colored, solid polymeric layers, said layers comprising an erodible skin engaging layer of a first color overlying a non-skin engaging layer of a different color, wherein said skin engaging layer is adapted to erode during contact with said skin during shaving to visually expose said non-skin engaging layer over time.

REQUEST FOR DECLARATION OF INTERFERENCE

If the claims of Doroodian '371 are directed to a different patentable invention from the subject matter involved in the Interference, then a second interference should be declared.

The second interference would be between Doroodian '371 and Tseng U.S. Application No. 08/926,819 ("Tseng '819"), filed September 10, 1997, a continuation of Tseng '318, filed June 20, 1995, a continuation-in-part of Tseng U.S. Application No. 08/269,495, filed on July 1, 1994, now abandoned.

Tseng submits that it is likely that claims in Doroodian '371 are directed to the same patentable invention as claims pending in Tseng '819. Tseng claim 32 could serve as the proposed count. Or, if the Examiner deemed it preferable, the Examiner, pursuant to 37 C.F.R. § 1.605(a), could suggest that Tseng add to the Tseng '819 application one or more of the claims in Doroodian '371.

Basis For Request For Interference

Each of Doroodian '371 and Tseng '819 is directed to a razor cartridge containing an indicator strip constructed to indicate a gradual change in the appearance of the strip during use of the razor cartridge.

Pursuant to 35 U.S.C. § 102(g), priority of invention is awarded to the first inventor to make the invention. The earliest filing date to which Doroodian '371 may be entitled is January 28, 1994. While Tseng '819 is entitled to an effective filing date of July 1, 1994, he has filed a Rule 131 Declaration establishing that he conceived and reduced to practice his invention prior to January 28, 1994 (July 1, 1997 Declaration Of Mingchih M. Tseng Under 37 C.F.R. § 1.131 submitted in Tseng '318). Based on this record, Tseng is the prior inventor and should be awarded priority, and Doroodian is not entitled to a patent on any claim directed to the subject matter claimed in Tseng '819.

As indicated above, Tseng initially proposed adding Doroodian '371 into the pending Interference between Tseng '318 and the Doroodian '331 patent. In view of the APJ's statements concerning delay in the Interference, and because the Interference has progressed further, Tseng is not seeking to add Doroodian '371 to the Interference, but rather submits that a separate interference is an appropriate means by which to resolve the matter of interfering applications.

CONCLUSION

Tseng submits that (1) if the claims of Doroodian '371 are directed to the same patentable subject matter as is involved in the Interference, its prosecution should be suspended pending the outcome of the Interference, or (2) if the claims of Doroodian '371 are directed to a separate

patentable invention from the subject matter of the
Interference, a second interference should be declared,
between Doroodian '371 and Tseng '819.

Respectfully submitted,



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